



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,595	12/30/1998	JEFFREY C. BELT	13237-2305-M	1356

27488 7590 04/25/2002

MERCHANT & GOULD
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

ANYA, CHARLES E

ART UNIT PAPER NUMBER

2151

DATE MAILED: 04/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

cd

Office Action Summary

Application No.

09/223,595

Applicant(s)

BELT ET AL.

Examiner

Charles E Anya

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 recites the limitation "the application program functionality" in lines 10.

There is insufficient antecedent basis for this limitation in the claim. MPEP 2173.05(e)

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 4 – 5 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 5,859,969 to Oki et. al.

As to claim 4, Oki teaches a Set of files ("...setting file 34...", "...set of files...", Col. 5, Ln. 48 – 54), Application functionality ("...software...", Col. 5, Ln. 48 – 54), a Network (Communication Line 22), Determining the set of files to be stored locally on

Art Unit: 2151

the computer ("... the host computer 21 prepares a setting file 34...", Col. 5, Ln. 48 – 54), Storing the set of files locally on the computer (Host Computer 21, Col. 5, Ln. 48 – 54), Identifying application functionality needed to run each file (First key table 32, Second key table 33, Col. 5, Ln. 9 – 20), Installing the identified application functionality locally on the computer ("...install...", Col. 5, Ln. 48 – 54).

As to claim 5, Oki teaches receiving user input (First key table 32, Second key table 33, Col. 5, Ln. 9 – 14), a plurality of files ("...plural software...", Col. 5, Ln. 9 – 14).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 – 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,195,678 B1 to Komuro in view of Oki et. al. and further in view of applicant's admitted prior art (Hereinafter referred to as APA, page 7 – 8).

As to claim 1, Komuro teaches a Computer (Terminal Computer T1, Terminal Computer T2), a Network (Network N1), a File ("specific resource file", Col. 5, Ln. 1 – 3), a Handler Routine (Server Computer A2), Sending each file to the identified handler routine ("In response to user's selection or request, the server computer A2...", Col. Ln. 52 – 60), Determining the application functionality required to execute each file ("...the server computer A2 determines the most suitable resource for the application...", Col. 4, Ln. 57

– 60). Komuro is silent with reference to a set of files and application program functionality.

Oki teaches a set of files (“...set of files...”, Col. 5, Ln. 48 – 54). It would have been obvious to apply the teaching of Oki to the system of Komuro. One would have been motivated to make such a modification in view of the fact that organizing files into sets of related files makes for better memory or resource management.

APA teaches the application functionality to comprise products (“Microsoft Office”, page 7, Ln. 31 – 34), features (“Word”, page 8, Ln. 3 – 10), Components (Component, page 8, Ln. 11 – 21). It would have been obvious to apply the teaching of APA to the system of Komuro. One would have been motivated to make such a modification if Microsoft Office is to be installed.

As to claim 2, see the rejection of claim 1.

As to claim 3, Komuro is silent with reference to identifying the set of files and storing the set of files on the computer.

Oki teaches identifying the set of files (“...setting file 34...”, “...set of files...”, Col. 5, Ln. 48 – 54), Storing the set of files on the computer (“...host computer 21...”, Col. 5, Ln. 48 – 54). It would have been obvious to apply the teaching of Oki to system of Komuro. One would have been motivated to make such modifications in that identifying files and storing them on the computer are logical steps of providing file resources to a remote computer.

7. Claims 6 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,859,969 to Oki et. al. as applied to claim 4 above in view of Komuro.

Art Unit: 2151

As to claim 6, Oki teaches searching a plurality of files (First key table 32, Second key table 33), determining whether each file found in the plurality of storage locations is to be stored locally on the computer (Circumstance file 31) and adding the file to the set of files (Setting file 34). Oki is silent with reference to a plurality of storage locations on the computer.

Komuro teaches a plurality of storage locations on the computer (F1, F1). It would have been obvious to apply the teaching of Komuro to the system of Oki. One would have been motivated to make such a modification in that the more storage locations that are available the more files retrieved.

As to claim 7, Oki is silent with reference to a type, a Handler Routine and sending each file to its associated handler.

Komuro teaches a type (File types (user file or system file), see figure 3B), a Handler Routine (Download Controller J12, Download Agent E11, Download Controller J11, Download Controller J13), and sending each file to its associated handler ("...sends the name of the application to the download controller J12", Col. 7, Ln. 58 – 61). It would have been obvious to apply the teaching of Komuro to the system of Oki. One would have been motivated to make such a modification in view of the fact that it allows files to be organized according to their type.

As to claim 8, Oki is silent with reference to the handler routine comprising of instructions for scanning each file and determining the application functionality that is needed to execute each file.

Art Unit: 2151

Komuro teaches to the handler routine to comprise of instructions for scanning each file (“...searches...”, Col. 8, Ln. 43 – 49) and determining the application functionality that is needed to execute each file (“...identifies...”, Col. 8, Ln. 43 – 49). It would have been obvious to apply the teaching of Komuro to the system of Oki. One would have been motivated to make such a modification in that allows for only relevant files downloaded as suggested in Komuro.

As to claim 9, see the rejection of claim 1.

8. Claims 10 – 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,195,678 B1 to Komuro in view of applicant’s admitted prior art (Hereinafter referred to as APA, page 7 – 8).

As to claim 10, Komuro teaches a set of application functionality (“...desired application...”, Col. 7, Ln. 52 – 54), a Computer (Terminal Computer T11), a Network (Network N11), a Document Identification Engine (Menu Processor M11, Col. 52 – 54), a list plurality of files (Resource Linkage Directory C11), a Document Mapping Engine (Application Manager I11, Col. 7, 23 – 25), a Proper Handler Routine (Download Controller J12), sending each file from the DME to the proper handler routine (Application Manager I11, Col. 7, Ln. 58 – 61), causing the handler routine to identify the application functionality needed to execute each file (Download Controller J12, Col. 7, Ln. 25 – 28), a list of needed application program (“...resource address information...”, Col. 7, Ln. 61 – 65), a Migration Engine (Download Agent E11a, Col. 8, Ln. 3 – 10), causing the Me to determine the current status of the needed application functionality (“Comparing...”, Col. 8, Ln. 10 – 14), if the status of the needed application

functionality is not installed locally on the computer, then causing the ME to install the needed application functionality to the computer (Download Agent E11a, Col. 8, Ln. 30 – 49). Komuro is silent with reference to a list of needed application program functionality.

APA teaches a list of needed application program functionality (Product, Features, Component, page 7 - 8, Ln. 31 – 34 and Ln. 1 – 21). It would have been obvious to apply the teaching of APA to the system of Komuro. One would have been motivated to make such a modification if Microsoft Office is to be installed.

As to claim 11, claim 10 meets the rejection of claim 11, since claim 11 is a computer-readable medium of claim 10.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E Anya whose telephone number is (703) 305-3411. The examiner can normally be reached on M – F (First Friday Off) from 8:30 am to 5:30 pm.

The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Application/Control Number: 09/223,595
Art Unit: 2151

Page 8

Charles E Anya
Examiner
Art Unit 2151

A handwritten signature in black ink, appearing to read "St. John Courtenay III". The signature is stylized with a large initial "S" and a long horizontal stroke at the end.

ST. JOHN COURTENAY III
PRIMARY EXAMINER